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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/893,905	06/29/2001	Akiko Naruse	04329.2589	4929

22852 7590 09/09/2004

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EXAMINER

HASHEM, LISA

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 09/09/2004

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/893,905

Applicant(s)

NARUSE ET AL

Examiner

Lisa Hashem

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4,5,8,11 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

FINAL DETAILED ACTION

1. Claims 2, 3, 6, 7, 9, 10, 13, and 14 have been cancelled by Applicant.
2. Claims 1, 4, 5, 8, 11, and 12 are presented for examination.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 4, 5, 8, 11, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over European Patent Application No. EP 498,997 by Martensson in view of JP Patent Application No. 2000134316 by Osamu.

Regarding claim 1, Martensson discloses a communication terminal (Figure 1, 1) adapted to be connected to a network which provides a service function for notifying of a message that contains a caller phone number, the communication terminal comprising (column 1, lines 1-14): a phone book or memory (Figure 2, 100) for storing user identification information containing a user phone number and a user name to be associated with the user phone number for each communication party user (column 2, lines 24-29); message receiving means for receiving the caller phone number in the message from said network included in an incoming call signal (column 6, lines 1-13); display mode setting means for selectively setting a first display mode for displaying only the received message received by said message receiving means (column 6, lines 11-32); and a second display mode for displaying only the stored user identification information stored in phone book (column 7, lines 2-21); determining means for inherently determining

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whether the first display mode or second display mode is set by said display mode setting means; and display control means for selectively displaying the received caller name and the stored user name corresponding to a stored user phone number that coincides with the received caller phone number according to the determination result of the determining means (Figure 5: 108, 114), wherein said display control means displays only the message received by said message receiving means, when the first display mode is set (column 6, lines 1-22; Figure 5, 108) and the display control means further comprises: comparing means for comparing the received caller phone number with each of the stored user phone number stored in said phone book, when the second display mode is set; and means for displaying the stored user identification information including said one of the stored phone number, when the received caller phone number coincide with one of the stored user phone number; wherein the text field in the memory does not include a field (column 6, line 42 - column 7, line 21; Figure 5, 114).

Martensson does not disclose a service function for notifying of a message that contains a caller phone number and a caller name, the communication terminal comprising: message receiving means for receiving the caller phone number and the caller name in the message from said network included in an incoming call signal.

Osamu discloses a communication terminal (Figure 1) adapted to be connected to a network which provides a service function for notifying of a message that contains a caller phone number and a caller name, the communication terminal comprising: a phone book or table (Figure 1, 8a) for storing user identification information containing a user phone number and a user name to be associated with the user phone number for each communication party user (Figure 2); message receiving means for receiving the caller phone number in the message from

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said network included in an incoming call signal; display mode setting means for selectively setting a first display mode for displaying only the received message received by said message receiving means; and a second display mode for displaying only the stored user identification information stored in phone book; determining means for inherently determining whether the first display mode or second display mode is set by said display mode setting means; and display control means for selectively displaying the received caller name and the stored user name corresponding to the stored user phone number which coincides with the received caller phone number according to the determination result of the determining means (see Abstract; section 0019, line 1 – section 0025, line 13; see Figure 3).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the communication terminal of Martensson to include a caller name in the message from said network as taught by Osamu, to provide identification of the source of call origination. One of ordinary skill in the art would have been lead to make such a modification since the called party can know detailed information related to the caller, such as a caller name. The received caller information that includes the caller name would be selectively displayed when the first display mode is set.

Regarding claim 4, the communication terminal according to claim 1 mentioned above, wherein Martensson further discloses the display control means further comprises comparing means for comparing the received caller phone number with each of the stored user phone number stored in said phone book, when the second display mode is set (column 6, line 14-16; column 6, lines 23-41).

Martensson fails to disclose means for displaying the received caller name, when the received caller phone number does not coincide with one of the stored user phone number is not stored in said phone book.

Osamu discloses the display control means further comprises comparing means for comparing the received caller phone number with each of the stored user phone number stored in said phone book, when the first display mode is set; and means for displaying the received caller name, when the received caller phone number does not coincide with one of the stored user phone number is not stored in said phone book (see Abstract; column 4, line 1 – column 5, line 15; see Figure 3).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the communication terminal of Martensson to include a caller name in the message from said network as taught by Osamu, to provide identification of the source of call origination. One of ordinary skill in the art would have been lead to make such modification since the called party can know detailed information related to the caller, such as a caller name. The received caller information that includes the caller name would be selectively displayed when the received caller phone number is compared with each of the stored user phone number stored in said phone book.

Regarding claim 5, the communication terminal according to claim 1 mentioned above, wherein Martensson further discloses, when said determining means determines whether the first display mode is set, a second display mode is set, or a third display mode for displaying both of the received message and user identification information stored in said phone book is set, and wherein, when it is determined by said determining means that the third display mode is set,

said display control means displays both of the message received by said message receiving means and said user identification information stored in phone book; wherein the text field in the memory includes a field, e.g. "TECHNOPHONE LTD" (column 7, lines 22-28; Figure 5, 115).

Regarding claims 8, 11, and 12, please see the rejection of the communication terminal in claims 1, 4, and 5 mentioned above, respectively, to reject the radio communication terminal in claims 8, 11, and 12.

Response to Amendment

5. In response to the remarks (pages 7-11), Examiner withdraws the 102 (b) rejection anticipated by Osamu for claims 6 and 13, since Applicant has cancelled these claims.

6. Applicant argues that the 103 rejection of Martensson in view of Osamu is improper because a translation of Osamu was not presented. Enclosed with this rejection is a translation of the Osamu reference.

7. Applicant also argues that Martensson in view of Osamu do not disclose 'display mode setting means for selectively setting a first display mode for displaying only the received message received by said message receiving means' and 'determining means for inherently determining whether the first display mode or second display mode is set by said display mode setting means'. Examiner disagrees.

Martensson clearly discloses a display mode display mode setting means for selectively setting a first display mode for displaying only the received message received by said message receiving means (column 2, line 58 – column 3, line 24; column 6, lines 11-32). Wherein, the first display mode is noted in Figure 5, 108. Further, Martensson discloses 'determining means for inherently determining whether the first display mode or second display mode is set by said

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display mode setting means' (Figure 5: 108, 114). Martensson further discloses a display mode means for a first display mode and second display mode and determining means for determining which display mode to set as shown in all rejections in claim 1 mentioned above (see Figure 5).

Osamu discloses clearly discloses a display mode display mode setting means for selectively setting a first display mode for displaying only the received message received by said message receiving means (section 0019, lines 9-12). Wherein, the first display mode is noted in Figure 4a. Further, Osamu discloses 'determining means for determining whether the first display mode or second display mode is set by said display mode setting means' (section 0018, lines 1-19). Osamu does not disclose a single mode, but Osamu discloses different display modes as shown in Figures 4a-4e. Osamu further discloses a display mode means for a first display mode (Figure 4a) and second display mode (Figure 4b) and determining means for determining which display mode to set as shown in all rejections in claim 1 mentioned above (see Figures 3 and 4).

It would have been obvious to combine Martensson to include a caller name in the message from said network as taught by Osamu to provide identification of the source of call origination (section 0019, lines 3-9), wherein information of the call origination is provided.

In conclusion, the claimed communication terminal is well met by the cited references above, please see the rejections and response above.

8. Intended Use Limitations: A recitation directed to the manner in which a claimed apparatus is intended to be used does not distinguish the claimed apparatus from the prior art – if the prior art has the capability to so perform (see MPEP 2114 and *Ex parte Masham*, 2 USPQ2d 1647 (1987). Thus the claim limitations in the examined claims above that employ phrases of

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type: "FOR" doing something, e.g. 'display mode setting means for', 'determining means for', etc. These are typical of claim limitations, which may not distinguish over the prior art. The references noted above have the structure and functions of performing the claimed limitations.

9. Applicant's arguments with respect to claims 1, 4, 5, 8, 11, and 12 have been considered but are moot in view of the new ground(s) of rejection.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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11. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to:

(703) 872-9314 (for formal communications intended for entry)

Or call:

(703) 306-0377 (for customer service assistance)

Hand-delivered responses should be brought to: Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).


12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa Hashem whose telephone number is (703) 305-4302. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703) 305-4895. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

LH

lh

August 30, 2004


ALLAN HOOSAIN
PRIMARY EXAMINER